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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,678	01/16/2004	B. Raghav Reddy	HES 2003-IP-011937U1	8611
28857	7590	08/27/2010		
CRAIG W. RODDY HALLIBURTON ENERGY SERVICES P.O. BOX 1431 DUNCAN, OK 73536-0440			EXAMINER MARCO'ANTONI, PAUL D	
			ART UNIT 1793	PAPER NUMBER
			NOTIFICATION DATE 08/27/2010	DELIVERY MODE ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte B. RAGHAV REDDY, ANTHONY V. PALMER, and
ASHOK K. SANTRA

Appeal 2009-013705
Application 10/759,678
Technology Center 1700

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL¹

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
decision to maintain the rejections of: (1) claims 1-8, 12, 14-15, 25-28,

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

30-36, 123-129, 134, 136-137, 144-156, 159-165, 170, 172, 173, and 180-190² under 35 U.S.C. § 102(b) as anticipated by Smith (US 4,393,939; Jul. 19, 1983) and (2) claims 1-12, 14-28, 30-39, 123-134, 136-170, and 172-191 under 35 U.S.C. § 103(a) as unpatentable over Smith or Booth (US 3,508,407; Apr. 28, 1970) alone or in view of Vijn (US 5,588,488; Dec. 31, 1996), Yamashita (US 6,087,418; Jul. 11, 2000), Laramay (US 6,089,318; Jul. 18, 2000), McCurich (US 4,131,480; Dec. 26, 1978) and Scheetz (“Effect of mix rheology, admixtures and salts upon physical and mechanical properties of hardened cement pastes,” Int’l Congr. Chem. Cem. Proc., 7th, vol. 3, pp. VI/170-VI/175 (1980)). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants’ invention relates to the use of settable fluids comprising particle-size distribution-adjusting agents in subterranean operations (Spec. ¶ [0001]). Claim 1 is illustrative:

1. A method of cementing, comprising:

providing a cement composition comprising a hydraulic cement, a set retarder, water, and a particle-size distribution-adjusting agent that comprises a cationic polymer;

permitting the cement composition to remain in a slurry state for a period of time prior to the cement composition being activated;

² The Examiner has included claims 16, 138-143, and 159 in the recitation of claims that stand rejected as anticipated. However, the Examiner makes clear in the rejection that these claims, directed toward a particular activator composition, are not anticipated by Smith (*see* Ans. 4, 7, 9, and 11).

activating the cement composition wherein activating the cement composition comprises adding an activator composition to the cement composition;

placing the cement composition in a subterranean formation penetrated by a well bore; and

permitting the cement composition to set therein.

II. ANTICIPATION

A. ISSUE ON APPEAL

A first issue on appeal arising from the contentions of Appellants and the Examiner is: does the evidence support the Appellants' view that the Examiner erred in finding that Smith teaches a process in which a cement composition is permitted to remain in a slurry state prior to being activated by adding an activator composition to the cement composition? We answer this question in the affirmative.

B. DISCUSSION

The Examiner asserts that the activator composition reads upon either water (which activates the hydraulic activity of the cement) or an accelerator which accelerates and activates the rapid setting of cement (Ans. 18-19). The Examiner further determines that claim 1 does not define a period of time and the activator (or accelerator) will still be in a slurry state at times of as low as one millionth of a second, a time encompassed by the claim (Ans. 20).

Appellants assert, among other things, that the Examiner has not shown that the cement composition of Smith remains in a slurry state prior to being activated (Br. 9 and 14).

We agree with Appellants that the Examiner has failed to provide sufficient fact finding to show that Smith anticipates the claimed method.

Claim 1 recites that the cement composition, comprising cement, a set retarder, water, and a particle-size distribution-adjusting (PSDA) agent, is permitted to remain in a slurry state “prior to the cement composition being activated” by “adding an activator composition to the cement composition.” Independent claims 123 and 159 further require that the cement composition be permitted to remain in a slurry state for “at least 24 hours” and “at least two weeks,” respectively. Each of the claims requires the activator to be added after the cement composition is formed into a slurry.

The Examiner has made no findings that Smith teaches the subsequent addition of either water or an accelerator to a cement slurry that already contains water. Smith only teaches the addition of water to form the cement into a slurry (Smith, col. 5, ll. 2-5). Smith teaches that the PSDA agent is compatible with an accelerator (Smith, col. 4, ll. 17-19). However, the Examiner has made no finding of a step of adding the disclosed accelerator after the cement composition has been made into a slurry in the teachings of Smith. Even more particularly, the Examiner has made no showing that Smith teaches adding an accelerator, or a subsequent water component, after the cement has been in a slurry for at least 24 hours or at least 2 weeks.

“[R]ejections under 35 U.S.C. § 102 are proper only when the claimed subject matter *is* identically disclosed or described ‘in the prior art.’” *In re*

Arkley, 455 F.2d 586, 587 (CCPA 1972). Therefore, in order to anticipate, a reference must identify something falling within the claimed subject matter with sufficient specificity to constitute a description thereof within the purview of § 102. *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978).

The Examiner has failed to show that Smith teaches the disclosed method with sufficient specificity as to the timing of the application of the activator for Smith to anticipate the independent claims.

III. OBVIOUSNESS

A. ISSUE ON APPEAL

A second issue on appeal arising from the contentions of Appellants and the Examiner is: does the evidence support the Appellants' view that the Examiner erred in concluding that a process in which a cement composition is permitted to remain in a slurry state prior to being activated by adding an activator composition to the cement composition would have been obvious to one of ordinary skill in the art based on the teachings of Smith or Booth, Vijn, Yamashita, and Laramay³? We answer this question in the negative.

B. DISCUSSION

Appellants do not present separate arguments for any particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claim 1.

We adopt the Examiner's findings in the Answer as our own and add the additional findings of fact appearing below for emphasis.

³ Appellants' arguments do not reach the Examiner's particular application of the teachings of McCurrich or Scheetz.

Appellants contend that the prior art would not have suggested to one of ordinary skill in the art the steps of permitting the cement composition to remain in a slurry state prior to the cement composition being activated by adding an activator composition to the cement composition (Br. 10-14; Reply Br. 15-16). In particular, Appellants argue that water, as taught by Smith and Booth, cannot function as an activator, and that the claimed activator and the accelerators taught by the prior art, are distinguishable based on the timing as to when the compositions are added to the cement compositions with respect to the set retarder (Br. 7-8; Reply Br. 11-13).

We are persuaded that the water used to form the cement composition into a slurry cannot constitute the “activator” recited in the claims, since the claims require the activator to be added after the slurry is formed. However, we are not persuaded that it would have been unobvious to the ordinary artisan to use the known accelerators as the activator in the manner recited in the claims.

Appellants admit that the compositions that constitute accelerators taught by the prior art are substantially similar to the what are generally referred to as activators, with the exceptions as to when the compositions are added to the cement compositions with respect to the set retarder (Br. 7, Reply Br. 10). However, the Examiner specifically finds that Appellants’ “order of adding retarder (delay set of cement) followed by activator (if accelerator) is what is conventionally done in the art” (Ans. 21). The Background of the Invention section of Appellants’ Specification supports the Examiner’s finding in stating that:

Set-delayed cement compositions are often utilized in circumstances where an operator finds it desirable to prepare a

volume of a cement composition that remains in a pumpable state for a long period of time (*e.g.*, for about two weeks or more), and that can be selectively activated to set into a hard mass at a desired time. . . . At a desired time, the set-delayed cement composition may be mixed with a set activating agent; the resulting mixture may then be placed into a desired location (*e.g.*, into a subterranean formation) and permitted to set therein.

(Spec. ¶ [0003]). In other words, Appellants admit that the order of adding activators after a set-delayed (retarded) cement composition has been permitted to remain in a slurry, even for a time period of two weeks or more, was known in the art.

Appellants cannot defeat an obviousness rejection with an argument directed to a claim feature which is acknowledged to be known in the prior art. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement . . . that something is in the prior art is binding on an applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (“[A] statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes.”).

IV. CONCLUSION

On the record before us and for the reasons discussed above, we cannot sustain the rejection maintained by the Examiner under 35 U.S.C. § 102(b) but sustain the rejection maintained by the Examiner under 35 U.S.C. § 103(a).

V. DECISION

We affirm the Examiner’s decision.

VI. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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